

Steven M. BESSETTE  
Appl. No. 10/014,797

Atty. Docket No. 4380-105

### REMARKS/ARGUMENTS

Claims 1, 7, 17, 20 and 140-145 are pending. Solely in an effort to advance prosecution, claims 1, 20 and 140-145 are amended to encompass infringing subject matter. Claims 2-6, 8-16, 18, 19, and 21-139 have been canceled without prejudice or disclaimer of the subject matter they contain. By the above amendments, no new matter has been added. Applicant does not acquiesce to the propriety of any of the Examiner's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Applicant reserves the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

Entry of the above amendment(s) is proper under 37 C.F.R. § 1.116 because the amendments: (a) places the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout the prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for the appeal. Thus, entry is respectfully requested.

### REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects claims 8 and 9 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention, and under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Solely in an effort to advance prosecution, claims 8 and 9 have been canceled, thereby rendering these rejections moot. Reconsideration and withdrawal are respectfully requested.

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**REJECTIONS UNDER 35 U.S.C. § 102(b)**

The Office Action rejects claims 1, 7-9 and 20 under 35 U.S.C. § 102(b) as being allegedly anticipated by DE 524 383. Applicants respectfully traverse this rejection.

The claimed invention is directed to a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally active ingredient, wherein the pesticidally active ingredient consists of rosemary oil and wintergreen oil. However, DE 524 383 merely discloses a composition for combating cockroaches, bugs, etc., containing all of the following ingredients: linseed oil, EtOH, KOH, benzene, Cl<sub>3</sub>CCOOH, anisole, refined petroleum, turpentine oil, rosemary oil, lemon oil, CH<sub>2</sub>O, wintergreen oil, terpinol, PhOH and benzaldehyde. As such, DE 524 383 does not disclose each and every element of the claimed invention. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

**REJECTION UNDER 35 U.S.C. § 103(a)**

The Office Action rejects claims 1, 7-9, 17, 20 and 140-145 under 35 U.S.C. § 103(a) as being allegedly unpatentable over DE 524 383 taken with the references by Inazuka et al., Watanabe, U.S. Pat. No. 4,379,168 (Dotolo), U.S. Pat. No. 6,004,569 (Besette) and U.S. Pat. No. 5,496,857 (Targosz). Applicants respectfully traverse this rejection.

In order to establish the requisite motivation, the Examiner is required to make a "thorough and searching" factual inquiry and, based upon that factual inquiry, explain why one having ordinary skill in the art would have been realistically compelled to modify a particular prior art teaching or teaching to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicants stress that the Examiner must provide clear and

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particular factual findings as to a specific understanding or specific technological principle underlying the motivation for the proposed modification of the acknowledged prior art to arrive at the claimed invention. *Ecolchem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000). Generalizations do not suffice. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

Applicants respectfully submit that the stark deficiencies of the teachings in DE 524 383 (e.g., a pesticidally active ingredient that consists of rosemary oil and wintergreen oil) are not remedied by Inazuka, Watanabe, Dotolo, Bessette and/or Targosz. Indeed, neither Inazuka, Watanabe, Dotolo, Bessette or Targosz, alone or in any proper combination, teach, suggest or provide any motivation to reach a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally active ingredient, wherein the pesticidally active ingredient consists of rosemary oil and wintergreen oil.

Inazuka merely discloses a **pest repellant** composition comprising rosemary oil as a sole active ingredient and a paper disk as a carrier. Inazuka teaches that rosemary oil is effective as a mosquito repellant. Inazuka does not teach, suggest or provide any motivation to add wintergreen oil to the disclosed repellant composition, let alone to achieve a pesticidal composition comprising a **pesticidally active ingredient** that consists of rosemary oil and wintergreen oil, as in the claimed invention.

Watanabe does not remedy the deficiencies of Inazuka. Watanabe merely discloses a pesticidal composition comprising wintergreen oil as a sole active ingredient and a paper disk or a petri dish as a carrier. Watanabe does not teach, suggest or provide any motivation to add rosemary oil to the disclosed repellant composition, let alone to achieve a pesticidal composition

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comprising a **pesticidally active ingredient** that consists of rosemary oil and wintergreen oil, as in the claimed invention.

Dotolo does not remedy the deficiencies of Inazuka or Watanabe. Dotolo merely discloses that benzyl alcohol and citronellal may be components of a pesticidal mixture. Dotolo does not teach, suggest or provide any motivation for a pesticidal composition comprising: (1) benzyl alcohol or citronellal as a carrier and (2) a **pesticidally active ingredient** that consists of rosemary oil and wintergreen oil, as in the claimed invention.

Bessette does not remedy the deficiencies of Inazuka, Watanabe or Dotolo. Bessette merely discloses d-limonene as a component of a pesticidal mixture. Bessette does not teach, suggest or provide any motivation for a pesticidal composition comprising: (1) d-limonene as a carrier and (2) a **pesticidally active ingredient** that consists of rosemary oil and wintergreen oil, as in the claimed invention.

Targosz does not remedy the deficiencies of Inazuka, Watanabe, Dotolo or Bessette. Targosz merely discloses safflower oil, soybean oil, sesame oil and mineral oil as components in pesticidal mixtures. However, Targosz does not teach, suggest or provide any motivation for a pesticidal composition comprising: (1) safflower oil, soybean oil, sesame oil or mineral oil, as a carrier, and (2) a **pesticidally active ingredient** that consists of rosemary oil and wintergreen oil, as in the claimed invention.

Thus, reconsideration and withdrawal of this rejection are respectfully requested.

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**CONCLUSION**

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner's Amendment), then please contact the undersigned attorney at the telephone number listed below.

Please grant any extension(s) of time deemed necessary for entry of this communication. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. 14-1140.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**Date: May 9, 2005By: 

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 872-9306 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office.

Date: May 9, 2005By: 

Willem F. Gadiano, Reg. No. 37,136